

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/142,983	09/18/98	JACKSON J	P50464-1

020462 HM22/0811
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EXAMINER
CRIARES, T

ART UNIT	PAPER NUMBER
1614	4

DATE MAILED: 08/11/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/142,983

Applicant(s)
Jackson et al

Examiner
Theodore J. Criares

Group Art Unit
1614



☒ Responsive to communication(s) filed on Sep 18, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-6 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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CLAIMS 1-6 ARE PRESENTED FOR EXAMINATION

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of the compounds of claim 5 to treat the disorders of claims 2-5, does not reasonably provide enablement for the mechanism of claim 1 for the mechanism claimed therein. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The compounds administered to treat inflammation as taught by applicants at page 3 of the specification would inherently inhibit the mechanism claimed in claims 1-6. See Ex parte Novitski 26 USPQ2d 1389.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 are under 35 U.S.C. 103(a) as being unpatentable over Clark (5,679,666), Beal, III et al (3,984,455) and Folkman et al. (5,001,116).

Clark teaches the use of compounds to treat neovascular disorders. See abstract.

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Beal, III et al teach at column 10 lines 13-26 compounds used to treat atherosclerosis.

It is well known that there are compounds which will treat metastasis, e.g., cisplatin.

Folkman et al teach compounds used to treat angiogenesis. See abstract.

That applicant may have determined a mechanism by which the active ingredient gives the pharmacological effect does not alter the fact that the compounds have been previously used to obtain the same pharmacological effects which would result from the claimed method. The patient, condition to be treated and the effect are the same. An explanation of why that effect occurs does not make novel or even unobvious the treatment of the conditions encompassed by the claims since the claims fail to limit the compounds which can be used..

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

Claims 5 and 6 would be favorably considered if placed in independent form.

None of the claims are allowed,

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T.J. Criares whose telephone number is (703) 308-4607. The examiner can normally be reached on Monday -Thursday from 9:00 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, Marianne Cintinis, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-7924.

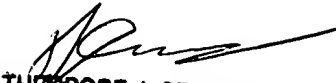
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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August 5, 1999


THEODORE J. CRIARES
PRIMARY EXAMINER
GROUP 1800
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